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BANNER & WITCOFF, LTD  
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WASHINGTON, DC 20005-4051

EXAMINER
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BUCHANAN, CHRISTOPHER R

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* J. CLARKE STEVENS and CAROL L. STIMMEL

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Appeal 2009-002217  
Application 09/396,612  
Technology Center 3600

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Before LINDA E. HORNER, HUBERT C. LORIN, and  
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## STATEMENT OF THE CASE

J. Clarke Stevens and Carol L. Stimmel (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 1-8 and 10 under 35 U.S.C. § 102(b) as anticipated by Green (US 5,664,110, issued Sep. 2, 1997). Claims 11-23 were withdrawn from consideration and claim 9 was canceled. We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

### *The Invention*

The claims on appeal relate to a method for automating the management of an inventory of consumer items at a consumer location. Spec. 1:4-5.

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for automating the management of an inventory of consumer items at a consumer location using a programmed device accepting input data and executing instructions for automating inventory management, the method comprising:
  - receiving a series of shopping lists, each shopping list including at least one item;
  - establishing a shopping list trend based on the series of shopping lists;
  - generating an output list in accordance with the shopping list trend such that the output list is predictive of a next shopping list;
  - receiving a plurality of item price lists from a corresponding plurality of shopping locations;
  - and
  - recommending a shopping location based on the plurality of item price lists and the output list.

### *The Rejection*

The Examiner finds that the claimed steps of 1) establishing a shopping list trend based on a series of shopping lists and 2) generating an output list in accordance with the shopping list trend such that the output list is predictive of a next shopping list are anticipated by Green. The Examiner determines such a finding based on Green disclosing: 1) an option list being activated when a user selects an icon and the customization of advertising to an individual based on that individual's buying patterns and 2) that a suggested or typical shopping list, provided by either the merchant or supplier or customized by the individual, is generated subsequent to the activation of the option list. Ans. 4.<sup>2</sup>

### *Contentions*

Appellants contend that “the suggested or typical shopping list” disclosed within Green is simply the result of the merchant or supplier suggesting a shopping list and this list is not predicated on any trend based on a series of received shopping lists as claimed. Reply Br. 3. Appellants also contend that while Green customizes the advertising to the individual based on the individual's buying patterns, the advertising is not used in predicting the next shopping lists. *Id.* Further, Appellants contend that Green's disclosure of the user customizing the shopping list is not predicated on any trend based on a series of shopping lists, but instead is based on a previously stored shopping list of the user. Reply Br. 4.

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<sup>2</sup> Citations to “Ans.” in this Decision refer to the Examiner's Answer mailed March 6, 2008.

## OPINION

### *Issue*

The determinative issue in this appeal is:

Whether Green's disclosure relied on by the Examiner anticipates the claimed steps of establishing a shopping list trend based on a series of shopping lists and generating an output list in accordance with the shopping list trend such that the output list is predictive of a next shopping list.

### *Pertinent Facts*

Green discloses a remote ordering system that provides the ability to compile one or more order lists, store and recall those lists, edit those lists, and transmit those lists to multiple merchant stock databases for ordering those items on the lists. In particular, after a general order list has been requested by a user, a suggested or typical shopping list is provided either by the merchant or supplier during the programming of the user's interface (DPU 10) within the remote order system. Alternatively, the user can create a customized list to be displayed upon selection of the appropriate icon on the user's interface. Col. 9, l. 66 to col. 10, l. 5. An aspect of the remote ordering system is the ability to present customized advertising to the user based on the user's buying patterns. Col. 12, ll. 22-27.

### *Analysis*

References are evaluated and applied on the basis of what they reasonably disclose and suggest to a person skilled in the art. *In re Aslanian*, 590 F.2d 911, 914 (CCPA 1979) (citing *In re Baum*, 374 F.2d 1004, 1009 (1967)). While the Examiner correctly looks to apply a broadest reasonable interpretation of the claim terms under examination, it is also necessary to

properly construe what an applied reference *fairly* teaches or discloses. *See, e.g., In re Fracalossi*, 681 F.2d 792 (CCPA 1982).

Here, the portions of Green relied upon by the Examiner do not fairly disclose the claimed steps of establishing a shopping list trend based on a series of shopping lists and generating an output list in accordance with the shopping list trend such that the output list is predictive of a next shopping list. At best, the portion of Green relied upon by the Examiner to find in part the claimed step of establishing a shopping list trend based on a series of lists does no more than provide customized advertisement based on buying patterns. While “buying patterns” can fairly be considered a “trend,” the Examiner has failed to explain how this “trend” is established based on a series of received lists as required by the claim. The portion of Green relied upon to find the claimed step of generating an output list in accordance with the trend such that the output list is predictive of the next shopping list is fairly understood as Appellants have characterized, i.e., the system can provide a suggested or typical shopping list based on the user selecting a general list. *See* Reply Br. 3-4. Further, the Examiner fails to explain how the customized advertisements demonstrate a shopping list trend to which any output list therefrom is predictive of a next shopping list.

## CONCLUSION

Green’s disclosure relied on by the Examiner does not anticipate the claimed steps of establishing a shopping list trend based on a series of shopping lists and generating an output list in accordance with the shopping list trend such that the output list is predictive of a next shopping list.

Appeal 2009-002217  
Application 09/396,612

DECISION

In view of the foregoing, the Examiner's decision to reject claims 1-8 and 10 as anticipated by Green is reversed.

REVERSED

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